

REMARKS

Favorable reconsideration of this application, as presently amended, is respectfully requested.

Drawings:

In response to the objection to the drawings, the Examiner is advised that formal drawings were submitted February 20, 2002. The Examiner is referred to publication 2003/0108347, in which the formal drawings appear.

Claims 2 and 22:

Applicant acknowledges the allowability of Claims 2 and 22, and presents those claims in independent form.

Claims 1, 3, 4, 8, 23 and 25:

Claims 1, 3, 4, 8, 23 and 25 stand rejected under 35 U.S.C. 102(e) as anticipated by Ueda et al. The rejection is respectfully traversed.

In the Office Action, it is proposed that the act of installing the Ueda et al. photographic processing apparatus can be considered the equivalent of the claimed step of "a service provider transporting a portable imaging system from a first location to a second location." To view Ueda et al. in such a way would require totally ignoring the term "portable" in the claim language. That term, as used throughout the specification of the present application and as defined in The American Heritage Dictionary, second college edition, means capable of being carried and/or easily moved. "Portable" clearly means that the imaging system is small enough and light enough to be carried by a service provider to a customer's home or other remote location. The photographic process and client administrative system disclosed by Ueda et al. clearly does not fall within the idea of portability. The portability feature of the present application is more than a mere convenience, but is basic to the ability to service customers at remote sites. As the court held in *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657,666 (Fed. Cir., 1985). Accordingly, the Examiner must give weight to the portability feature of the claims.

The idea of portability aside, the Office Action next views the attendant who receives an order from a customer at the photo-shop as the "service provider." Since the Examiner has already considered the person who transports the imaging system from a first location to a second location to be the "service provider," it would seem that the attendant and the transporter must necessarily be the same entity. There is nothing in the Ueda et al. disclosure that would support this conclusion. Nor would it be logical to believe that the entity that delivers and installs the imaging system of Ueda et al. to be a store clerk.

Claims 3 and 4 depend from Claim 1 and are patentable for at least the same reasons.

Claim 8 defines the step of a service provider copying an image using a portable kiosk. As discussed above with respect to Claim 1, Ueda et al. do not disclose the use of a portable kiosk. Accordingly, there is at least one claimed feature that is not disclosed in the reference applied.

Claim 23 defines structure produced by the method of Claim 1. Accordingly, at least for the reasons set forth above with respect to Claim 1, Ueda et al. does not disclose the method of Claim 1 nor the structure produced according to that method.

Claim 25 defines a product with a computer storage medium having instructions to effect the method of Claim 1. For at least the reasons set forth above, Ueda et al. disclose neither the method of Claim 1 nor the structure of Claim 25 produced according to that method.

Claims 7, 9 and 16-20:

Claims 7, 9 and 16-20 stand rejected under 35 U.S.C. 102(e) as anticipated by Ichikawa. The rejection, as it applies to the claims as herein amended, is respectfully traversed. In Claim 7, the sequence of claimed steps is:

1. transporting,
2. accessing,
3. scanning,
4. storing,
5. generating an order request, and
6. transporting to the first location.

In contrast, the interpretation Ichikawa suggested in the Office Action involves “after the images are captured the digital camera is returned to the rental item providing machine and the user generates an order request to print the images that were captured.” The difference in sequence is significant given the intended environment of the present invention, in that the customer does not return to the first location with the portable imaging system. Accordingly, Claim 7 includes at least one feature not found in the cited art.

As amended, Claims 9 and 16 call for the step of scanning the image on a hard copy document that is provided at the first location. The analysis of Ichikawa in the Office Action is that the process of clocking acquired image data out of a CCD sensor is often referred to as “scanning” and that this process can be literally interpreted as meeting the claimed step of “scanning the visual image.” While applicant disagrees that scanning a visual image is the same as scanning data from a CCD, the present amendment further defines the process as

scanning a hard copy document to produce a digital image. This clearly is not anticipated by the Examiner's interpretation of Ichikawa.

Claims 17-19 depend from Claim 16 and are patentable at least for the reasons set forth above with respect to Claim 16.

Claim 20 depends from Claim 19 and is patentable therewith. Further, Claim 20 calls for sending the image product to the user by third-party delivery service. The Office Action points out that a user of Ichikawa, can pick up his or her order from a hotel front desk. Having a customer come to a service desk to pick up an order is not equivalent in theory or in practice of "sending" the order to the customer. Nor is a desk clerk considered to be a "delivery service" as that phrase is used in the present application or as commonly thought of by the public.

Claims 6, 10-15 and 24:

Claims 6, 10-15 and 24 are rejected under 35 U.S.C. 103(a) as obvious over Ueda et al. The rejection is respectfully traversed.

As regards Claim 6, this claim depends from Claim 1 and is patentable therewith. Further, the opinion set forth in the Office Action that it would have been obvious for a photo-shop and a photo processing facility to split fees does not address the claim feature of a service provider who scans an image at a remote site with a portable imaging system receiving a credit from a concern that produces an image product. The service provider as claimed is neither a photo-shop nor a photo processing facility. Nor is the service provider the equivalent of either.

With respect to Claims 10-15 and 24, the Office Action proposes that the act of installing the Ueda et al. photographic processing apparatus can be considered the equivalent of the claimed step of "a service provider transporting a portable imaging system to a first location." To view Ueda et al. in such a way would require totally ignoring the term "portable" in the claim language. That term, as used throughout the specification of the present application and as defined in The American Heritage Dictionary, second college edition, means capable of being carried and/or easily moved. "Portable" clearly means that the imaging system is small enough and light enough to be carried by a service provider to a customer's home or other remote location. The photographic process and client administrative system disclosed by Ueda et al. clearly does not fall within the idea of portability. The portability feature of the present application is more than a mere convenience, but is basic to the ability to service customers at remote sites. As the court held in *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227

USPQ 657,666 (Fed. Cir., 1985). Accordingly, the Examiner must give weight to the portability feature of the claims.

The idea of portability aside, the Office Action next views the attendant who receives an order from a customer at the photo-shop as the "service provider." Since the Examiner has already considered the person who transports the imaging system from a first location to a second location to be the "service provider," it would seem that the attendant and the transporter must necessarily be the same entity. There is nothing in the Ueda et al. disclosure that would support this conclusion. Nor would it be logical to believe that the entity that delivers and installs the imaging system of Ueda et al. to be a store clerk.

Still with respect to Claims 10-15 and 24, the opinion in the Office Action that it would have been obvious for a photo-shop and a photo processing facility to split fees does not address the claim feature of a service provider who scans an image at a remote site with a portable imaging system receiving a credit from a concern that produces an image product. The service provider as claimed is neither a photo-shop nor a photo processing facility. Nor is the service provider the equivalent of either.

Claim 21:

Claim 21 stands rejected under 35 U.S.C. 103(a) as unpatentable over Ichikawa. The rejection is traversed. Claim 21 depends from Claim 16 and is patentable therewith. Additionally, the use of Official Notice that photo-processing service providers used e-mail to send finished images to users as a common practice at the time that the invention was made is traversed. The Examiner is requested to cite a reference in support of such an assertion. MPEP 706.02(a)

Claim 5:

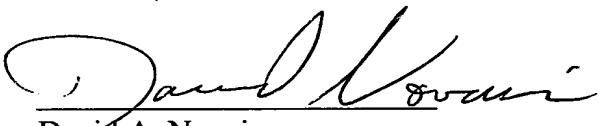
Claim 5 stands rejected 35 U.S.C. 103(a) as unpatentable over Ueda et al. in view of Golasinski et al. The rejection is traversed. Ueda et al. fails as the underlying reference as discussed above with respect to Claim 1. Further, Golasinski relates to the payment of a bill at a remote site such as a kiosk. The Ueda et al. apparatus is not located at a remote site, but rather at a photo-shop, as pointed out on page 3 of the Office Action. The photo-shop is fully staffed, also as pointed out in the Office Action, and there is no need for payment via a kiosk. Although Ueda et al. may be readily modifiable in "the manner suggested by the Examiner", this does not "make the modification obvious" and there is no motivation to one skilled in the art to modify the subject matter of Ueda et al. in

light of the teachings of Golasinski et al. "It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 23 USPQ2d 1780 (CAFC 1992). The mere fact that a reference could be modified does not make "the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Conclusion:

In view of the foregoing comments, it is submitted that the inventions defined by each of claims 1-25 are patentable, and a favorable reconsideration of this application is therefore requested.

Respectfully submitted,



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